Supreme Court, U.S.
FILED
FEB 29 2016
OFFICE OF THE CLERK

No. 15-446

In the

Supreme Court of the United States

CUOZZO SPEED TECHNOLOGIES, LLC,
Petitioner,

v.

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF THE FEDERAL CIRCUIT BAR ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

EDGAR H. HAUG
PRESIDENT
FEDERAL CIRCUIT BAR ASSOCIATION
1620 I Street, N.W
Suite 900
Washington, DC 20006

MORGAN CHU*
**Counsel of record*
JOSEPH M. LIPNER
DENNIS J. COURTNEY
Irell & Manella LLP
1800 Ave. of the Stars
Suite 900
Los Angeles, CA 90067-4276
(310) 277-1010
mchu@irell.com

Counsel for Amicus Curiae

February 29, 2016

TABLE OF CONTENTS

Page

INTEREST OF *AMICUS CURIAE* 1

INTRODUCTION AND SUMMARY OF ARGUMENT 2

ARGUMENT 4

I. CLAIMS SHOULD BE CONSTRUED IN IPR PROCEEDINGS AS THEY ARE IN DISTRICT COURT 4

A. The Court has established appropriate rules for claim construction 4

B. The BRI standard arose from, and should be limited to, examination practice 6

II. THE BOARD'S USE OF THE BRI STANDARD REDUCES CERTAINTY, PREDICTABILITY, AND FAIRNESS IN THE PATENT SYSTEM 9

A. Multiple validity standards frustrate the value of providing the public with notice 9

B. The use of the BRI standard in IPR proceedings decreases predictability 11

Page

C. **The application of different validity standards results in unfairness** 14

CONCLUSION 16

TABLE OF AUTHORITIES

Page(s)

Cases

Abbott Labs. v. Cordis Corp.,
710 F.3d 1318 (Fed. Cir. 2013) 7

Cimiotti Unhairing Co. v. Am. Fur Ref. Co.,
198 U.S. 399 (1905) 5

Cont'l Paper Bag Co. v. E. Paper Bag Co.,
210 U.S. 405 (1908) 5

ePlus, Inc. v. Lawson Software, Inc.,
790 F.3d 1307 (Fed. Cir. 2015) 12, 13

Facebook, Inc. v. Pragmatus AV, LLC,
582 F. App'x 864 (Fed. Cir. 2014) 12

Ford Motor Co. v. Paice LLC,
IPR2014-00884, 2015 WL 8536739 (P.T.A.B. Dec. 10, 2015) 13

Garmin Int'l, Inc. v. Cuozzo Speed Techs, LLC,
IPR2012-00001, 108 U.S.P.Q.2d 1852 (P.T.A.B. Nov. 13, 2013) 13

In re Cuozzo Speed Techs., LLC,
793 F.3d 1268 (Fed. Cir. 2015) 3, 8, 11, 14

In re Cuozzo Speed Techs., LLC,
793 F.3d 1297 (Fed. Cir. 2015) 6, 8, 14

Page(s)

In re Etter,
756 F.2d 852 (Fed. Cir. 1988) 7

In re Morris,
127 F.3d 1048 (Fed. Cir. 1997) 7

Marine Polymer Tech., Inc. v. Hemcon, Inc.,
672 F.3d 1350 (Fed. Cir. 2012) 15

Markman v. Westview Instruments, Inc.,
517 U.S. 370 (1996) 4

Microsoft Corp. v. Proxyconn, Inc.,
789 F.3d 1292 (Fed. Cir. 2015) 12

Nautilus, Inc. v. Biosig Instruments, Inc.,
134 S. Ct. 2120 (2014) 10

Oracle Corp. v. Crossroads Sys. Inc.,
IPR2014-01207, 2016 WL 380195 (Jan. 29, 2016)
..... 13

Phillips v. AWH Corp.
415 F.3d 1303 (Fed. Cir. 2005) 5, 6, 12

Power Integrations, Inc. v. Lee,
797 F.3d 1318 (Fed. Cir. 2015) 13

PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC,
___ F.3d ___, No. 2015-1364, 2016 WL 692369
(Fed. Cir. Feb. 22, 2016) 11

Page(s)

PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC,
___ F.3d ___, Nos. 2015-1361, 2015-1369, 2015-1366, 2015-1368, 2016 WL 692368 (Fed. Cir. Feb. 22, 2016) 11

PSC Comput. Prods, Inc. v. Foxconn Int'l, Inc.,
355 F.3d 1353 (Fed. Cir. 2004) 10

Solid, Inc. v. Corning Optical Commc'ns Wireless Ltd.,
IPR2015-01170, 2015 WL 7304685 (P.T.A.B. Nov. 16, 2015) 13

White v. Dunbar,
119 U.S. 47 (1886) 5

Statutes

35 U.S.C. § 112(b) (2012) 10

35 U.S.C. § 251 (2012) 7

35 U.S.C. § 305 (2012) 7

35 U.S.C. § 316 (2012) 2

35 U.S.C. § 316(d) (2012) 14

35 U.S.C.§ 318(c) (2012) 15

Act of July 4, 1836, Ch. 357, 5 Stat. 117 (1836) 5

Page(s)

Other Authorities

Brian J. Love & Shawn Ambwani, *Inter Partes Review: An Early Look at the Numbers*, 81 U. CHI. L. REV. DIALOGUE 93, 103 (2014) 9

Dawn-Marie Bey & Christopher A. Cotropia, *The Unreasonableness of the Patent Office's 'Broadest Reasonable Interpretation' Standard*, 37 AIPLA Q. J. 285 (2009) 12

Eric C. Cohen, *A Primer on Inter Partes Review, Covered Business Method Review, and Post-Grant Review before the Patent Trial and Appeal Board*, 24 FED. CIR. B. J. 1, 18 (2014) 12

H.R. Rep. No. 112–98, pt. 1 (2011) 7

MPEP § 2011.01 (9th ed. Rev. 7, Nov. 2015) 6

MPEP § 2111.01 (9th ed. Rev. 7, Nov. 2015) 12

MPEP § 2173 (9th ed. Rev. 7, Nov. 2015) 10

Saurabh Vishnubhakat et al., *Strategic Decision Making in Dual PTAB and District Court Proceedings*, BERKELEY TECH. L. J. (forthcoming 2016)..... 9

INTEREST OF *AMICUS CURIAE*

Amicus curiae the Federal Circuit Bar Association (the "Association") [1] is a national organization for the bar of the Court of Appeals for the Federal Circuit.[2] The Association was organized to unite the different groups that practice within the legal community of the Federal Circuit, and its membership includes private and government attorneys, federal judges, law clerks, and others. The Association offers a forum for common concerns and dialogue between bar and court, government counsel and private practitioner, litigator, and corporate counsel.

Many members of the Association work in the area of patent law. Despite their diversity of practices and interests, the members of the Association share an interest in settled, reliable jurisprudence regarding important issues in patent law. This is particularly true with regard to the law of claim construction. As a part of their practices, the members of the Association rely on the determinations of both district courts and the Patent

---

[1] No counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae*, its members, or its counsel made a monetary contribution to its preparation or submission. Further, in the Association, no government board or association members participated in the decision to file the amicus brief or in shaping the contents of the brief.

[2] Respondent's written consent to this filing is submitted herewith. Petitioner consented to the filing of *amicus curiae* briefs in support of either party or neither party in a docket entry dated February 3, 2016.

and Trademark Office ("PTO") regarding the scope of claims in issued patents, and thus the members have an interest in predictable, certain rules regarding the interpretation of such claims.

INTRODUCTION AND SUMMARY OF ARGUMENT

The Association submits this *amicus curiae* brief to recommend a rule under which the Patent Trial and Appeal Board (the "Board") must construe patent claims in *inter partes* review ("IPR") proceedings according to the same standard that is used by district courts.[3]

The use of a single claim construction standard for both IPRs and district court litigation is legally appropriate and would add certainty and simplicity to the law governing patents.

The American Invents Act ("AIA") created both IPRs and the Board in 2012. In an IPR proceeding, a panel of judges from the Board decides whether a petitioner has proved that claims in an issued patent are unpatentable. The Board renders its decision after litigation-like proceedings (that may include discovery, depositions, expert testimony, briefing, and oral argument) in which the petitioner has the burden of proof. 35 U.S.C. § 316 (2012).

---

[3] The Association expresses no opinion on the second issue on which the Court granted certiorari: the judicial reviewability of the Board's decision to institute IPR proceedings.

The validity of a patent claim is determined by its scope, and therefore the outcome of IPR proceedings is often determined by how the Board construes patent claims. Because IPR proceedings are analogous to district court patent validity litigation in which claim construction is also of critical importance, and there is a preexisting standard for construing claims in that context, the Board should adhere to that established standard when construing claims in an IPR.

Instead, the Board in this case and in other IPR decisions chose to use the "broadest reasonable interpretation" ("BRI") standard, which has its origins in the examination of patent applications. This choice cannot be reconciled with the purpose of IPR proceedings, and is not justified by the PTO's custom of applying the BRI standard in other contexts. Consistency within the PTO is cited as one reason to apply the BRI standard in IPR proceedings, *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1279 (Fed. Cir. 2015), but consistency with district courts is a more pressing concern. Most IPR proceedings involve patents that are (or become) the subject of district court litigation. The standard of claim construction should not depend on the forum in which validity is argued and adjudicated.

Having two alternative frameworks for interpretation conflicts with a key value of the patent system: the patent is supposed to give clear notice to the public of what it means. This value requires a single meaning for claim terms, not two or more depending on the forum. In addition, the use of a non-litigation standard in IPR proceedings

disrupts the patent system whether or not any particular claim actually receives a "broader" construction under the BRI standard. Because claims in district court are construed the same way for validity as they are for infringement, unfairness can result whenever the two standards do lead to different outcomes. In such cases, the Board's use of a non-litigation standard forces patentees to defend claim scope that they would never have been able to assert — and even amendment (if available) may not correct this problem, due to the possible assertion of an intervening rights defense.

A variety of stakeholders devote substantial resources to adjudication of patent rights. These include the parties on both sides of patent disputes and the attorneys who advise and represent them. These stakeholders, as well as the public, would benefit from having a single standard for assessing the validity of claims in both IPRs and district court litigation.

ARGUMENT

I. CLAIMS SHOULD BE CONSTRUED IN IPR PROCEEDINGS AS THEY ARE IN DISTRICT COURT

A. The Court has established appropriate rules for claim construction

A patent claim is that "portion of the patent document that defines the scope of the patentee's rights." *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

In 1836, Congress first required that a patent specification include "claims," in which the inventor "shall particularly specify and point out the part, improvement or combination, which he claim as his own invention or discovery." Act of July 4, 1836, Ch. 357, 5 Stat. 117, 119 (1836). Since then, this Court has consistently required that district courts construe patent claims according to the plain meaning that the claims would have had to a skilled artisan. "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms." *White v. Dunbar*, 119 U.S. 47, 52 (1886). "In making his claim the inventor is at liberty to choose his own form of expression, and while the courts may construe the same in view of the specifications and state of the art, they may not add to or detract from the claim." *Cimiotti Unhairing Co. v. Am. Fur Ref. Co.*, 198 U.S. 399, 410 (1905). "[T]he claims measure the invention. They may be explained and illustrated by the description. They cannot be enlarged by it." *Cont'l Paper Bag Co. v. E. Paper Bag Co.*, 210 U.S. 405, 419 (1908).

In accordance with these directives, district courts employ the so-called *Phillips* standard in construing disputed terms in patent claims. *Phillips v. AWH Corp.* 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Under *Phillips*, claim terms are "generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art at the time of the invention, as informed by the

specification and the prosecution history of the patent. *Id.* at 1312, 1316, 1317.

B. The BRI standard arose from, and should be limited to, examination practice

When the PTO examines a patent application in the first instance, the PTO examiner gives claims their interpretation under the BRI standard. MPEP § 2011.01 (9th ed. Rev. 7, Nov. 2015).

The PTO's use of the BRI standard in examination has traditionally been justified because it helps examiners work with patentees to define the "metes and bounds" of patent rights *before* claims issue. *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1297, 1300 (Fed. Cir. 2015) (Prost, J., dissenting from denial of rehearing en banc). The premise is that a "broadest reasonable" interpretation gives examiners flexibility in identifying prior art that is arguably covered by an applicants' claims, forcing applicants to stake out the boundaries of their inventions with greater clarity. As the Federal Circuit noted in upholding the use of the BRI standard in examination, "[i]t would be inconsistent with the role assigned to the PTO in issuing a patent to require it to interpret claims in the same manner as judges" because "[t]he process of patent prosecution is an interactive one. Once the PTO has made an initial determination that specified claims are not patentable, the burden of production falls upon the applicant to establish entitlement to a patent. This promotes the development of the written record before the PTO that provides the requisite written notice to the public as to what the

applicant claims as the invention." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (citations omitted).

While the application of the BRI standard in reissuance and reexamination is more controversial, these proceedings are different from IPRs in that they are arguably more concerned with defining the metes and bounds of the claims rather than with adversary proceedings about the patent. *See, e.g.*, *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1988) (en banc) (noting that in reexamination "claims can be amended and new claims added, *and where no litigating adversary is present*") (emphasis added), *Abbott Labs. v. Cordis Corp.*, 710 F.3d 1318, 1326 (Fed. Cir. 2013) (noting that the purpose of creating IPR proceedings was "to 'convert[] inter partes reexamination from an examinational to an adjudicative proceeding'") (alteration in original) (quoting H.R. Rep. No. 112–98, pt. 1, at 46 (2011)). Accordingly, whether or not the BRI standard is appropriate for reissue or reexamination proceedings, it is not appropriate for IPRs.[4]

In IPR proceedings, only the *validity* of patent claims is at issue. The focus is not on the prospective benefit of clarifying claim language, but on the scope of the grant actually made to the

---

[4] Moreover the use of the BRI standard in the reissue and reexamination contexts is arguably justified by statutory language requiring these proceedings to operate as examination: 35 U.S.C. § 251 (2012) allows the PTO to reissue a patent only "on the surrender of such patent," and 35 U.S.C. § 305 (2012) requires a reexamination to "be conducted according to the procedures established for initial examination." By contrast, the AIA contains no similar language requiring claims in IPR proceedings to be submitted to examination.

patent-holder. Moreover, an IPR proceeding is fundamentally adversarial — a "surrogate" for district court litigation. *In re Cuozzo Speed Techs.*, 793 F.3d at 1284 (Newman, J., dissenting). As the dissenters from the denial of Cuozzo's petition for rehearing en banc observed:

> [A]n IPR is a curtailed, trial-like proceeding meant to efficiently resolve a challenge to patent validity. It may only be instituted on limited grounds, and must conclude within one year (unless extended for six months upon a showing of good cause). The proceeding consists of a brief period of discovery, one round of briefing by the petitioner and challenger, and an oral hearing, before the Board issues its final decision. Given the absence of examinational hallmarks justifying the broadest reasonable interpretation standard in other contexts, and the similarities to district court litigation, it is unclear to us why the district court standard should not apply.

In re Cuozzo Speed Techs., 793 F.3d at 1301 (Prost, J., dissenting) (citations omitted).

The parallels between district court litigation and IPR proceedings go beyond the fact that they can decide the same issue and have similarities in procedure. As empirical studies have shown, most patents in IPR proceedings are (or become) the subject of district court litigation between the same

parties.[5] The use of a single standard in both proceedings would promote consistency in outcomes, and reduce the number of disputes that reach both forums simply because one party believes that the law might be more favorable in a second forum.

II. THE BOARD'S USE OF THE BRI STANDARD REDUCES CERTAINTY, PREDICTABILITY, AND FAIRNESS IN THE PATENT SYSTEM

A. Multiple validity standards frustrate the value of providing the public with notice

There are many reasons that having two different claim construction standards for validity challenges violates procedural fairness and simple common sense. For example, having different standards for interpreting patent claims apply

---

[5] *See, e.g.*, Saurabh Vishnubhakat et al., *Strategic Decision Making in Dual PTAB and District Court Proceedings*, BERKELEY TECH. L. J. (forthcoming 2016) (manuscript at 24) (noting that 70% of IPR petitioners had previously been defendants in litigation involving the patents at issue); Brian J. Love & Shawn Ambwani, *Inter Partes Review: An Early Look at the Numbers*, 81 U. CHI. L. REV. DIALOGUE 93, 103 (2014) ("Overall, in 80 percent of IPRs, the challenged patent was also asserted in litigation between the petitioner and respondent"). Inter partes reexamination, the infrequently used predecessor of IPR proceedings, was similarly an adjunct to litigation. *See, e.g.*, U.S. Patent and Trademark Office, *Ex Parte Reexamination Filing Data – September 30, 2014* (last updated July 8, 2015), http://www.uspto.gov/sites/default/files/documents/inter_parte_historical_stats_roll_up_EOY2014.pdf (76% of all inter partes reexaminations through September 2014 related to patents known to be in litigation).

depending on where a party chooses to challenge a patent's validity violates one of the most fundamental concerns of the patent system: that the patent, as written, provide the public with notice as to the scope of its claims.

The concern that patents give the public clear notice of what is claimed is central to how the patent system works. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014) ("a patent must be precise enough to afford clear notice of what is claimed"); *PSC Comput. Prods, Inc. v. Foxconn Int'l, Inc.*, 355 F.3d 1353, 1360 (Fed. Cir. 2004) ("[t]he ability to discern both what has been disclosed and what has been claimed is the essence of public notice"). The PTO's own manual of examining procedure emphasizes that "it is of utmost importance that patents issue with definite claims that clearly and precisely inform persons skilled in the art of the boundaries of protected subject matter," and refers to this notice function as the "primary purpose" of the statutory requirement that claims "particularly point[] out and distinctly claim[] the subject matter" of an invention. MPEP § 2173 (9th ed. Rev. 7, Nov. 2015); 35 U.S.C. § 112(b) (2012).

The Board's use of the BRI standard in IPR proceedings is at odds with this mandate, as in some instances it may *require* different governmental entities to assign different meanings to the same words. If the requirement of notice to the public means anything, it means that patents have a particular meaning — not one or more meanings depending on where a party decides to challenge the patent. The purpose of notice to the public is

undermined when tribunals "charged with determination of patent validity as a matter of law could validly reach a different result on the same evidence." *In re Cuozzo Speed Techs.*, 793 F.3d at 1290 (Newman, J., dissenting). This basic concern militates in favor of having only one standard, not two.

B. The use of the BRI standard in IPR proceedings decreases predictability

In requiring practitioners to assess patent validity under two standards, the use of the BRI standard in IPR proceedings also needlessly complicates patent analysis and diminishes predictability. *Compare PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, ___ F.3d ___, No. 2015-1364, 2016 WL 692369, at *5 (Fed. Cir. Feb. 22, 2016) (finding that the difference in claim construction standards did not determine the outcome) *with PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, ___ F.3d ___, Nos. 2015-1361, 2015-1369, 2015-1366, 2015-1368, 2016 WL 692368, at *4 (Fed. Cir. Feb. 22, 2016) (finding that the difference in claim construction standards was "outcome determinative"). Patent practitioners now have to analyze and attempt to advise their clients about how patents will fare under two sets of rules, increasing costs and decreasing the ability of patent-holders and accused infringers to have settled expectations. The Board's decision ensures that the IPR system, instead of being simply a faster and more efficient complement to district court litigation, remains a fundamentally different process with a separate body of decisional law.

This problem arises even if the BRI standard and the district court standard as a practical matter lead to the same result in many cases. Complicated jurisprudence exists attempting to delineate the substantive differences between the standards, with some cases and commentators suggesting that the differences are small or non-existent,[6] and others expressing the view that the BRI standard generally leads to "broader" constructions (i.e., constructions that expand the scope of potentially invalidating prior art).[7]

---

[6] *See, e.g.*, Eric C. Cohen, *A Primer on Inter Partes Review, Covered Business Method Review, and Post-Grant Review before the Patent Trial and Appeal Board*, 24 FED. CIR. B. J. 1, 18 (2014) (questioning whether there is "much, if any, difference in the application" of the standards); *compare Phillips*, 415 F.3d at 1312–17 (district courts should give claims their "ordinary and customary meaning" as understood by a person of ordinary skill in the art, as informed by the specification and prosecution history) *with Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) (BRI standard "does not include giving claims a legally incorrect interpretation," "must be consistent with the one that those skilled in the art would reach," and considers claims in light of both the specification and the prosecution history, when available). *See also* MPEP § 2111.01 (9th ed. Rev. 7, Nov. 2015) (repeatedly quoting *Phillips* to explain aspects of the BRI standard).

[7] *See, e.g., ePlus, Inc. v. Lawson Software, Inc.*, 790 F.3d 1307, 1314 (Fed. Cir. 2015) (Moore, J., dissenting) (arguing that the BRI standard "makes invalidation based on prior art easier"), *Facebook, Inc. v. Pragmatus AV, LLC*, 582 F. App'x 864, 869 (Fed. Cir. 2014) (nonprecedential) (noting that claim scope under BRI "may be the same as or broader" than claim scope under *Phillips*), Dawn-Marie Bey & Christopher A. Cotropia, *The Unreasonableness of the Patent Office's 'Broadest Reasonable Interpretation' Standard*, 37 AIPLA Q. J. 285, 303 (2009) (noting that the BRI rule "necessarily contemplates a

Whatever the outcome of this debate,[8] the Board's use of a non-litigation standard introduces undesirable and counterproductive strategic considerations into the patent system. Parallel standards uniquely incentivize parties to take extreme positions to test the boundaries of the rules, or to otherwise engage in gamesmanship. *See, e.g.*, *ePlus*, 790 F.3d at 1314, 1314 n.1 (Moore, J., dissenting) (questioning the "wisdom and propriety of the applicability of the [BRI] standard in IPR proceedings" in case where defendant sought to "rely on the PTO" to "undo" a loss in district court). Because of its use of a different standard, the Board is not bound by previous judicial constructions of disputed terms,[9] and the extent to which the Board must even consider such constructions is unclear. *Power Integrations, Inc. v. Lee*, 797 F.3d 1318, 1326–

---

larger resulting claim scope than a district court would determine").

[8] In this case, Cuozzo contended before the Board that the Board's BRI construction of a claim was too narrow in one respect, while the Board acknowledged that Cuozzo's proposed construction was "not broader" but "diametrically different." *Garmin Int'l, Inc. v. Cuozzo Speed Techs, LLC*, IPR2012-00001, 108 U.S.P.Q.2d 1852 (P.T.A.B. Nov. 13, 2013).

[9] *Compare Solid, Inc. v. Corning Optical Commc'ns Wireless Ltd.*, IPR2015-01170, 2015 WL 7304685 (P.T.A.B. Nov. 16, 2015) (rejecting district court's construction of disputed term and deciding to institute IPR) *and Ford Motor Co. v. Paice LLC*, IPR2014-00884, 2015 WL 8536739, at *5 (P.T.A.B. Dec. 10, 2015) (rejecting district court's construction of disputed term and invalidating claim) *with Oracle Corp. v. Crossroads Sys. Inc.*, IPR2014-01207, 2016 WL 380195, at *4 (Jan. 29, 2016) (adopting district court's claim construction "[a]lthough we are not bound by the construction or reasoning of the district court").

27 (Fed. Cir. 2015) (suggesting that the Board has an obligation to "acknowledge" prior judicial constructions, but expressly declining to hold "that the board must in all cases assess a previous judicial interpretation of a disputed claim term"). If the Board employed the same standard as district courts, each forum would address prior constructions made in the other, increasing the consistency of outcomes.

C. The application of different validity standards results in unfairness

Because infringement is assessed according to the district court standard, unfairness can result from the Board's use of a different standard in IPR proceedings.

Whenever the BRI construction is broader than the district court construction, the Board's use of the BRI construction in an IPR proceeding requires a patent-holder to defend a claim scope that it never received from the PTO. *In re Cuozzo Speed Techs.*, 793 F.3d at 1305 (Prost, J., dissenting). As there is no objective standard for the "broadest" interpretation required by the BRI rule, the patent-owner cannot even anticipate in advance what this scope will be.

The interaction between the much-debated availability of amendment during IPR and intervening rights is another potential source of unfairness. During an IPR proceeding, the right to amend is "cabined," *In re Cuozzo Speed Techs.*, 793 F.3d at 1278, but it is sometimes available. 35 U.S.C. § 316(d) (2012). But "amended or new claim[s] determined to be patentable" are subject to

intervening rights. 35 U.S.C.§ 318(c) (2012). Application of the BRI rule in an IPR proceeding may end up giving a patent owner the Hobson's choice of either amending claims to clarify that they have only the scope that they would have been given in district court (and exposing itself to an assertion of intervening rights), or having the Board find its claims unpatentable. *See, e.g., Marine Polymer Tech., Inc. v. Hemcon, Inc.*, 672 F.3d 1350, 1362-63 (Fed. Cir. 2012) (en banc) (rejecting intervening rights when PTO initially construed the claims more broadly than the district court only because there was no formal amendment). The fact that this curious result can occur in IPR proceedings is purely a consequence of the Board's choice to follow the BRI rule.

CONCLUSION

Patent claims should be given the same scope in IPR proceedings that they are given in district court. The Federal Circuit's decision to allow the Board to construe claims according to a different standard deprives bench, bar, and litigants alike of the clarity of having a single standard. Consistent with basic fairness, predictability, and the purpose of IPR proceedings, the Court should uphold the principle that there is only one way to assess the validity of a claim in an issued patent.

Respectfully submitted,

EDGAR H. HAUG
PRESIDENT
FEDERAL CIRCUIT BAR ASSOCIATION
1620 I Street, N.W.
Suite 900
Washington, DC 20006

MORGAN CHU*
*Counsel of record
JOSEPH M. LIPNER
DENNIS J. COURTNEY
Irell & Manella LLP
1800 Ave. of the Stars
Suite 900
Los Angeles, CA 90067-4276
(310) 277-1010
mchu@irell.com

February 29, 2016

Counsel for Amicus Curiae